



Application No. 09/864,240
Inventor: Norman Duncan

Art Unit 3625

Examiner James H. Zurita
Filed May 25th 2001

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

A. Acknowledgment of Action

Office Action Summary

1. Applicant respectfully acknowledges the Office action dated February 27th 2003 as:
 - (a) "Responsive to communication(s) filed on 04 November 2002";
 - (b) being non-final;
 - (c) disposing claim 1 as pending and rejected;
 - (d) having a Notice of References Cited (PTO 892) attached.

RECEIVED

AUG 01 2003

Prosecution History

GROUP 3600

2. Applicant respectfully acknowledges Examiner's recital of the prosecution history of the present application for patent before the U.S. Patent Office and humbly submits that one rather obvious and trivial error appears therein regarding the filing and granting dates for the petition to make special: "Applicant filed a Petition to make special on 25 November 2001, (paper #2). The Petition was granted on 8 November 2001 (paper #3)." (4th Office action, page 2, second paragraph).

Disposition of Appeal

2. Applicant respectfully acknowledges Examiner's statement that "Applicant filed a notice of appeal on 8 July 2002 (paper #9)" and that "No appeal brief has been filed."
3. Applicant respectfully acknowledges Examiner's: recitation of MPEP 1206 reciting 37 CFR 1.192(a); and recognition that "the appeal stands dismissed and the appeal proceedings as to the rejected claim are terminated with reference to 37 CFR 1.192(b)".

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

Preliminary Technical Notes

4. Applicant respectfully recites in full Examiner's statements regarding 'misleading' terminology:

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Although applicant's use of the terms 'URL' 'subaddress' and '*unique compound address*' is not repugnant, applicant's use of these terms is misleading and inconsistent with their meaning and usage.

Claim 1 uses the term 'URL' to refer to a 'Universal Resource Locator', as in the disclosures. The term 'Universal Resource Locator' is also used by *URL Newspaper Ads*. The accepted meaning of URL is *Uniform Resource Locator*, which is an address for a resource on the Internet. URLs are used by web browsers to locate Internet resources. A URL specifies the protocol to be used in accessing the resources, the name of the server on which the resource resides (such as *//www.whitehouse.gov*), and *optionally the path to a resource (such as an HTML document or a file on that server)*.¹ A URL may uniquely identify a specific file or image on a particular logical or physical server.

By definition, a URL/Uniform Resource Locator already includes what applicant refers to as a '*unique compound address*' and a '*subaddress*', i.e., identifier(s) after a domain name that uniquely identify the path to a resource such as a file or document.

The two URLs below point to two different files at the domain *sandybay.com*. The first specifies an executable file that should be fetched using the FTP protocol; the second specifies a Web page that should be fetched using the HTTP protocol:

<ftp://www.microsoft.com/stuff.exe>

<http://www.pcwebpopedia.com/index.html>²

Similarly, claim 1's '*subaddress*' and '*unique compound address*' refer to those portions of a URL that *uniquely* identify a resource such as a file, graphic, etc.

Applicant has not shown that his use of the term URL varies from how

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 the term is defined or used by the Examiner, or as used in the various
2 references, or as used in the various references. For purposes of this
3 examination, applicant's use of URL will be interpreted to mean a Uniform
4 Resource Locator. Applicant's use of the term *subaddress* will be interpreted
5 to mean that portion of a URL after a domain name (www.microsoft.com) that
6 identifies a particular resource such as a file (including a graphics or image
7 file) or document.

8 Applicant alleges that his use of 'subaddress' provides a patentable
9 distinction over prior art. For example,

10
11 Applicant respectfully submits that use of a subaddress
12 patentably distinguishes the presently claimed invention over the
13 prior art because without this subaddress either:

14 (a) a separate URL is required for each printed classified; or
15 (b) 'a reader of the published printed classified' is brought only
16 to a specific URL necessarily having a number of graphic
17 images representative of all the printed classifieds and the
18 'reader' *must browse* through what is essentially an online
19 classified section, thereby rendering the printed classifieds
20 superfluous. (Paper 11, page 8, lines 14-20).

21
22 Similarly, under 'Specific Patentable Distinctions' applicant states that

23
24 [...] the use of a subaddress in a unique compound Internet
25 address by the presently claimed invention provides a specific
26 patentable distinction because without a subaddress in a unique
27 compound Internet address the prior art can only provide a
28 graphic image online of the subject of a printed classified by
29 requiring a separate URL for each printed classified. (Paper #11,
30 page 24, lines 21-25)

31
32 As shown above, these statements are misdescriptive. Further, there are
33 various other addressing schemes that permit a user to go directly to a resource
34 such as a specific image or a specific web page, obviating the need for a user
35 to 'browse through . . . an online classified section,' which applicant claims

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 as a patentable distinction. The techniques include logical addressing schemes
2 (as disclosed by Blewett), absolute URLs, Relative URLs, Fragment URLs.
3 At least these techniques were widely used and were well known to those of
4 ordinary skill in the art at the time the invention was made.

5
6 ¹ Definition of URL, Microsoft Computer Dictionary, *emphasis added*.

7 ² Definition of URL, Computer & Internet Dictionary, Random House
8 Webster's. (4th Office Action, pages 3 - 5)
9

10
11 5. Applicant respectfully acknowledges, in particular from the above quoted
12 'Preliminary Technical Notes', Examiner's contention that applicant's language is
13 'misdescriptive': "As shown above, these statements are misdescriptive. Further, there are
14 various other addressing schemes that permit a user to go directly to a resource such as a
15 specific image or a specific web page, obviating the need for a user to 'browse through . . .
16 an online classified section,'" (4th Office action, page 5, last paragraph).

17
18 6. Applicant respectfully acknowledges what are considered the most pertinent
19 statements by Examiner in the fourth Office action with regard to the use of 'misdescriptive'
20 nomenclature:

21 (a) "Applicant's use of the term *subaddress* will be interpreted to mean that portion of
22 a URL after a domain name (www.microsoft.com) that identifies a particular resource
23 such as a file (including a graphics or image file) or document" (*Ibid.*, first quote);

24 (b) "Applicant alleges that his use of 'subaddress' provides a patentable distinction over
25 prior art" for reasons including 'because without a subaddress . . . the prior art can
26 only provide a graphic image online . . . by requiring a separate URL for each printed

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 classified”” (*Ibid.*, second quote).

2
3 *Response to Request for Reconsideration*

4 7. Applicant respectfully recites Examiner's repetition of the rejection conveyed in the
5 previous Office action:

6 Applicant's request for reconsideration, arguments and remarks of 4
7 November 2002 (paper #11) have been fully considered but they are not
8 persuasive.

9 Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable
10 over an article by Steve Outing, Newspapers bar URL's in ads, Editor &
11 Publisher, v. 13 n. 15, p. 6, 11 April 1998, accessed from the Internet on 28
12 June 2002, DialogWeb accession number 01616529-02-67518 [hereinafter
13 URL Newspapers Ads]. (4th Office Action, page 6).
14
15
16

17 8. Applicant respectfully and gratefully acknowledges the admission by Examiner in the
18 fourth Office action that the single reference relied upon in rejection of the sole claim of the
19 present application for patent in the third Office action fails to mention, and hence is
20 incapable of disclosing or suggesting, anything corresponding to the 'subaddress' identified
21 by Applicant as critical to distinguishing the presently claimed invention over the known
22 pertinent prior art and the single reference relied upon in rejection in the third Office action
23 in particular: "Examiner acknowledges that *URL Newspaper Ads* does not say *subaddress*."
24 (4th Office Action, page 6).
25
26

continued

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

9. Applicant respectfully acknowledges the reasons set forth in the fourth Office action in support of the above stated repetition of the rejection of present claim 1 conveyed in the third Office action:

(a) "The reference shows that a greater number of newspapers wish to continue the existing practice of allowing URLs in print." (4th Office Action, page 6)

(b) "For example, the Patriot-News . . . bans the use of URLs, parlance for universal resource locators . . . while several others [publishers] report they allow URLs in print liners." (4th Office Action, last paragraph of page 6)

(c) "Thus, applicant's arguments fail to consider the remainder of the abstract and, more importantly, the contents of the article." (4th Office Action, first paragraph of page 7)

10. Applicant respectfully acknowledges Examiner's reasons for refusal to recognize Applicant's argument that the only reference cited in rejection teaches away from the presently claimed invention and that skepticism in that reference cited by Examiner in rejection constitutes objective evidence of non-obviousness:

Applicant alleges that he has submitted objective evidence of non-obviousness and that these submissions overcome rejections of his claim (paper #11, pages 16-24).

In response to this argument, to be of probative value, any objective evidence should be supported by actual proof. (4th Office action, page 7);

and respectfully notes that the statement that objective evidence 'should' be supported by 'actual proof' to be of 'probative value' is lacking any citation of statute, case law, regulation or MPEP in support of this contention.

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 11. Applicant respectfully acknowledges Examiner's repetition of the reason given in the
2 previous Office action for improper use of hindsight: "so long as it . . . does not include
3 knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper."
4 (4th Office action, page 7)

5
6 12. Applicant respectfully acknowledges Examiner's allegation that the previous obvious
7 action did not rely upon a single reference in rejection of present claim 1: "*URL Newspaper*
8 *Ads* was combined with knowledge generally known to one of ordinary skill in the art at the
9 time the invention was made, such as the ordinary definition of the term URL." (4th Office
10 action, page 8)

11
12 13. Applicant respectfully acknowledges Examiner's admission that the presently claimed
13 invention addresses a problem that is unrecognized by the prior art generally and the only
14 reference relied upon in rejection conveyed in the previous Office action particularly: "Even
15 if one were to interpret applicant's invention as addressing a need not already raised and
16 addressed by *URL Newspaper Ads*, it is noted that the features upon which applicant relies
17 (i.e., extra-cost option) are not recited in the rejected claims(s)." (4th Office action, page 8)

18
19 14. Applicant respectfully recites, in full, Examiner's rebuttal of Applicant's 'allegation'
20 of Examiner's improper use of hindsight of the presently claimed invention in modification
21 of prior art that teaches away from that modification:

22
23 Applicant alleges that the claimed combination of a URL and a portion
24 of an address that uniquely identifies a web page are based on applicant's

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 disclosures (sic). In response, see *Preliminary Technical Notes*, above, for
2 definitions of URL, unique compound address and subaddress. (4th Office
3 action, page 8)
4
5

6 ***Claim Rejections - 35 USC § 102***

7 15. Applicant respectfully acknowledges Examiner's quotation of 35 U.S.C. 102(b).
8

9 16. Applicant respectfully acknowledges Examiner's rejection of claim 1 "under 35
10 U.S.C. 102(b) based upon a public use or sale of the invention by North Fork Mountain Inn".
11 (4th Office action, last paragraph of page 8).
12

13 17. Applicant respectfully acknowledges Examiner's support of rejection under 35 U.S.C.
14 102(b) recited above including the following statements:

15 (a) September 1998 issue of *Washingtonian* magazine . . . shows the title, volume and
16 date . . . address and phone numbers for services, including advertising services,
17 where advertiser may submit materials for printed classifieds in the magazine" (4th
18 Office action, pages 8 - 9);

19
20 (b) North Fork Mountain Inn Web Page. Examiner provides a screen print image
21 of the subject of a printed classified . . . demonstrates the use of a business
22 method that,

23 As in Claim 1, subsection (a), Page 171, Washington Classified,
24 describes that advertisers may submit materials, including specific graphic
25 images . . . Representative of a subject for a printed classified: 'Send ad copy
26 to Washingtonian Classified' . . .

27 As in Claim 1, subsection (b), North Fork Mountain Inn Web Page

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 shows a web page that was created upon a web site possessing a specific URL.

2
3 As in Claim 1, subsection (c), North Fork Mountain Inn Web Page 12-
4 01-98 shows that the web page was assigned a unique compound address,
5 including a specific URL and a subaddress that enables direct access to the
6 web page thought (sic) the World Wide Web with entrance of the unique
7 compound address. The NETSCAPE location toolbar shows a unique
8 compound address" (4th Office Action, pages 9 - 10);
9

10 As in Claim 1, subsection (d), The printed classified for North Fork .
11 . . includes, within the printed classified, the subaddress assigned to the
12 specific web page and the specific URL; and
13

14 As in Claim 1, subsection (e), a reader of the published printed
15 classified may enter the unique compound address while online and directly
16 view the digital reproduction of the specific graphic image that is
17 representative of the subject of the published printed classified. (4th Office
18 action, page 10)
19

20
21 18. Applicant respectfully acknowledges Examiner's statement that neither *North Fork*
22 *Mountain Inn* nor the *Washingtonian* "does not employ the vernacular 'subaddress' (but as)
23 discussed in the Preliminary Technical Notes, above, (in) 'reading on' the public use by the
24 North Fork Inn . . . (it shows) a unique compound address and a specific URL and a
25 subaddress to its web page." (4th Office action, page 10) and respectfully notes that the
26 *Washingtonian*, or the advertisement by *North Fork Inn* placed therein, is the only reference
27 cited in support of rejection of present claim 1 under 35 U.S.C. 102 and that, being a
28 magazine, or an advertisement placed therein, the use of the "vernacular 'subaddress'"
29 therein would be acknowledged as a surprise to the present applicant.

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

Claim Rejections - 35 USC § 103

19. Applicant respectfully recites Examiner's supply of the authority for rejections as obvious in the fourth Office action: "The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action." (4th Office action, page 10)

20. Applicant respectfully acknowledges Examiner's rejection of claim 1 "under 35 U.S.C. 103(a) as being unpatentable over an article by Steve Outing, Newspapers bar URL's in ads" (4th Office action, last paragraph, page 10).

21. Applicant respectfully acknowledges Examiner's statement that: "*URL Newspaper Ads does not employ the vernacular term 'subaddress.'*" (4th Office action, page 12)

22. Applicant respectfully acknowledges Examiner's statement in support of the above cited rejection of present claim 1 under 35 U.S.C. 103: "As noted above, it was well known to one of ordinary skill . . . that a URL may include what applicant refers to as a *subaddress*, i.e. identifier(s) after a domain name that uniquely identify the path to a resource such as a file or document." (4th Office action, pages 12 - 13)

23. Applicant respectfully acknowledges Examiner's argument that, despite the lack of any mention of a 'subaddress' by the only reference relied upon in the fourth Office action in the above cited rejection of present claim 1 under 35 U.S.C. 103, "it would have been obvious . . . to combine the disclosures found in *URL Newspapers Ads* with knowledge generally available in the art, to place a URL in a printed classified, said URL including what

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 applicant refers to as a *subaddress*.” (4th Office action, page 13)

2
3 24. Applicant respectfully acknowledges Examiner’s argument that the motivation for the
4 ‘combination’ referenced immediately above exists: for the obvious reason that advertisers
5 may wish to place ads in various media, including printed classifieds” and “(e)ach different
6 medium may contain references to a URL”, that:

7
8 (b)y pointing to a single source of a particular image, an advertiser may keep
9 track of what advertisements he places, and also may save money by posting
10 one single specific image related to an item he wishes to sell. In addition,
11 persons who see an item being advertised in various media would realize that
12 the item being referred to is the same unique item. For example, someone who
13 sees an advertisement for a house in a printed classified such as a newspaper
14 would realize that the ad refers to the same house as she saw in a magazine or
15 in a television ad or a billboard. (4th Office action, last paragraph of page 13)
16

17
18 25. Applicant respectfully acknowledges Examiner’s rejection of claim 1 “under 35
19 U.S.C. 103(a) as being unpatentable over the 1999 issue of United Airlines Hemispheres”,
20 although “Hemispheres does not employ the vernacular ‘subaddress’”; because this
21 reference:

22
23 show(s) multiple subjects in a printed classified published in a publication”
24 including “a unique compound address, URL and what applicant refers to as
25 a subaddress . . . that directly, specifically and uniquely identifies the subject
26 of the printed classified (here, Sony’s CONTACT model videoconference
27 product). (4th Office action, page 14)
28

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 26. Applicant respectfully acknowledges Examiner's statement, understood to be in
2 support of the rejection acknowledged immediately above, that:

3
4 ContactProductWebPage contains a screen print of www.sony.com/video-
5 conference of 27 April 1999 . . . archived . . . on 09 March 2000 (and)
6 retrieved on 21 February 2003" that "includes a specific digitally reproduced
7 graphic of Sony's CONTACT(TM) model videoconference product advertised
8 on pages 140 and 142 of Hemispheres. (4th Office action, penultimate
9 paragraph, page 14)
10
11

12 27. Applicant respectfully acknowledges Examiner's statement, with regard to 'Sony's
13 model videoconference product advertised on pages 140 and 142 of Hemishperes', that: (t)he
14 specific image represents the subject of the printed classified." (4th Office action, page 14)
15

16 28. Applicant respectfully acknowledges Examiner's statement, immediately following
17 the statement acknowledged immediately above, that:

18
19 "Therefore, it would have been obvious to . . . combine Hemispheres with
20 knowledge generally available to those of ordinary skill in the art . . . to
21 provide a method of doing business incorporating the combined teachings of
22 the Sony printed classified and the related screen print image." (4th Office
23 action, pages 14 - 15)
24
25

26 29. Applicant respectfully acknowledges, and further respectfully recites in full and
27 verbatim, what is understood to be an assertion regarding the obviousness now of the
28 presently claimed invention in view of the Sony advertisement referenced by Examiner and

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

acknowledged immediately above:

One of ordinary skill in the art at the time the invention was made to combine Hemispheres with knowledge generally available to those of ordinary skill in the art of electronic commerce at the time the invention was made to provide a method of doing business incorporating the combined teachings of the Sony printed classified and the related screen print image for the obvious reason that by including a URL and what applicant refers to as a subaddress, a business executive on a commercial flight would be able to access the internet and directly review detailed product information such as provided by Sony. Thus, an executive can make good use of idle time and evaluate communication products that would enhance his company's productivity. By increasing the ability of his employees to communicate, a business is better able to evolve with technology and provide better services to their customers. This creates a customer's feeling of well-being, increased revenues, higher employment and a healthy economy. (4th Office action, page 15)

Conclusion

30. Applicant respectfully acknowledges Examiner's direction of enquiry to his office and provision of telephone numbers for: the same, his supervisor, fax, and reception.

B. Submission of Evidence Overcoming Grounds of Rejection

Language Issues

1. Applicant respectfully submits that since Examiner:

(a) plainly objects to the term URL, but

(b) accepts a definition of 'subaddress' as "that portion of a URL after a domain name

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 ... that identifies a particular resource”;
2 all the language issues involved can be easily resolved with an Examiner's Amendment
3 included in allowance replacing 'URL' with 'domain name' and, if further desired,
4 'compound address' with 'URL'.

5
6 2. Applicant respectfully submits that one of the examples of 'misdescriptive' language
7 cited by Examiner from Applicant's last response to the third Office action, not the present
8 claim or specification, illustrates a misunderstanding of the claimed invention: “Applicant
9 alleges that his use of 'subaddress' provides a patentable distinction . . . 'because without
10 a subaddress . . . the prior art can only provide a graphic image online . . . by requiring a
11 separate URL for each printed classified” wherein it is clear that the point of this
12 'allegation' is missed: each separate subaddress without a domain name can be printed in
13 each classified and, when combined by the user online with a domain name used for the all
14 the printed classifieds in that section, brings up at least one graphic of the item advertised;
15 whereby the use of one URL or domain name by many different classified advertisers is
16 enabled and the considerable cost of obtaining a domain name and building a web site by
17 each advertiser obviated.

18
19 *Claim Rejection - 35 USC § 102*

20 3. Applicant respectfully submits that North Fork Mountain Inn, or the advertisement
21 placed thereby in the *Washingtonian*, does not constitute “a public use or sale of the
22 invention” because there is no use of a single URL or domain name associated with the
23 'classifieds' by the publication that any advertiser can use with a subaddress in their

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 classified advertisement, that while "wvweb.com" might be construed as a URL or domain
2 name it is clearly limited to entities within the state of West Virginia.

3
4 4. Applicant respectfully submits that North Fork Mountain Inn, or the advertisement
5 placed thereby in the *Washingtonian*, does not constitute "a public use or sale of the
6 invention" because the presently claimed limitation: "having the printed classified published
7 in a publication with inclusion of said subaddress assigned to said web page within said
8 printed clasified and said specific URL printed in said publication in association with printed
9 classifieds published therein" is lacking.

10
11 5. Applicant respectfully submits that:

- 12 a. a 'classified' advertisement in a newspaper necessarily comprised at the time
13 of the present invention, and at the present time, type set print without
14 graphics owing to the required printing process used for the classified section;
15 b. the advertisement cited by Examiner in rejection of the presently claimed
16 invention under 35 U.S.C. 102 contains a graphic and hence is not a
17 newspaper 'classified' advertisement;
18 c. the present invention is intended for newspaper classifieds, has been used in
19 newspaper classifieds, and can be easily restricted to newspaper classifieds;
20 d. restriction of the present claim to "a printed newspaper classified" would
21 clarify the intention of the present invention and patentably distinguish the
22 presently claimed subject matter over the prior art cited by Examiner in
23 rejection under 35 U.S.C. 102.

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

Claim Rejections - 35 USC § 103

5. Applicant respectfully submits that, in addition to the evidence submitted in the last response by Applicant overcoming all reasons in support of the repeated rejections conveyed by the fourth Office action, the affidavits submitted herewith constitute objective evidence of non-obviousness overcoming all grounds of rejection under 35 U.S.C. 103 utilized in any and all of the Office actions to date in examination of the presently claimed invention, the present application for patent, and its single claim under the following grounds:

- a. Skepticism on the Part of the Pertinent Industry: (Affidavits (a), (b) & (d))
- c. Fulfillment of Long Felt But Unresolved Need in Pertinent Industry; (All Affidavits)
- d. Resolution of Distinct Problem in Pertinent Industry; (Affidavits (a), (b) & (c))
- e. Unquestioned Novelty of Solution; (Affidavits (a), (b) & (c))
- f. Copying by Others (Affidavits (c) & (d))
- g. Infringement by Others (Ibid. & color copy from iPIXads)

6. Applicant respectfully submits that the affidavits following by:

- (a) Michelle Ackerman, Sales Development Manager of the Denver Newspaper Agency;
 - (b) Janet De George, President, Classified Executive Training and Consulting, of Gilbert, Arizona;
 - (c) Daniel R. Arenson, investor in the business making "Mr. Duncan's system" a reality as easily verified by visiting www.ADpixx.com;
 - (d) Norman Duncan, the inventor;
- comprise evidence attesting to the grounds 9a. - g.) listed directly above.

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

C. Summary and Request for Allowance

Filing of this Response

1. Applicant respectfully submits that the present response has been timely filed with a cheque payable to 'Commissioner for Patents' in the amount of \$205 for filing within the second month in accordance with 37 CFR 1.117(a)(2).

Language Issues

2. Applicant respectfully submits that the language issues raised by Examiner in the fourth Office action can be easily resolved by Examiner's Amendment accompanying Allowance replacing 'URL' with 'domain name' and 'compound address' with 'URL'.

Rejection Under USC § 103

3. Applicant respectfully submits that all the rejections under U.S.C. 103(a) conveyed in the fourth Office action, comprising the bulk of this action, comprise a repetition of the rejections conveyed in the third Office action, that all points of the same have been dutifully recited in the present response, and that response to the third Office action overcomes all the grounds for these rejections.

4. Applicant respectfully submits that the affidavits following herein constitute objective evidence overcoming all grounds of all rejection under 35 U.S.C. 103 conveyed by the fourth Office action and all other rejections under 35 U.S.C. 103 outstanding.

continued

APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

Rejection Under USC § 102

5. Applicant respectfully submits that the rejection under U.S.C. 102 conveyed in the fourth Office action is overcome by the evidence presented in the present response demonstrating that the reference relied upon in this rejection fails to include a necessary limitation of the presently claimed invention as evidenced by the recitation of said limitation from the present, unamended and verbatim as filed, claim 1, the sole claim of the present application for patent.

6. Applicant respectfully submits that the rejection under 35 U.S.C. 102 conveyed in the fourth Office action can also readily be overcome by Examiner's Amendment accompanying Allowance inserting the word 'newspaper' between the words 'printed' and 'classified' in the first and fifth phrases of present claim 1 following the preamble:

- a. "receiving a submission inclusive of a specific graphic image provided by a submitter and representative of a subject for a printed newspaper classified",
- b. "whereby a reader of the published printed newspaper classified may enter said unique compound address while online and directly view said digital reproduction of said specific graphic image representative of said subject for said published printed newspaper classified";

and replacing the word 'publication' with 'newspaper' in the fourth phrase following the preamble of the present claim along with insertion of 'newspaper' between 'printed' and 'classified':

- c. having the printed newspaper classified published in a [publication] newspaper with inclusion of said subaddress assigned to said web page within said printed newspaper

Application No. 09/864,240
Inventor: Norman Duncan

Art Unit 3625

Examiner James H. Zurita
Filed May 25th 2001

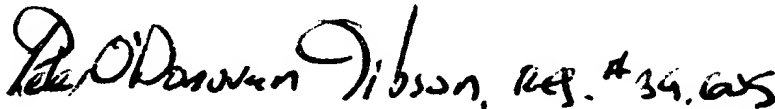
APPLICANT'S RESPONSE TO FOURTH OFFICE ACTION

1 classified and said specific URL printed in said [publication] newspaper in
2 association with printed classifieds published therein".

3
4 *Request for Allowance*

5 7. Applicant respectfully submits that all grounds of rejection have been overcome for
6 the reasons set forth above, that the grounds of rejection under 35 U.S.C. 102 can also be
7 overcome by Examiner's Amendment accompanying Allowance as set forth above, and that
8 all objections can be easily met by Examiner's Amendment accompanying Allowance as set
9 forth above, thereby placing the present application in full and proper condition for
10 allowance, which action Applicant humbly and respectfully invites and requests forthwith.

11
12 Respectfully yours,

13 
14

15 Peter O'Donovan Gibson, Reg. #34,605

16 Tel. 410/358-5912; Fax -9636